

LEGAL FRAMEWORK FOR THE USE OF THE ELECTRONIC FILING SYSTEM

This document explains the legal framework for the treatment of patent applications filed under the Electronic Filing System (EFS). It describes how an electronic application will be processed by the United States Patent and Trademark Office (USPTO or Office) and clarifies some issues concerning these applications and the regulations of the USPTO.

General Rule: Effect of Patent Regulations

Effect of Patent Regulations

Section 22 of title 35 of the United States Code expressly provides for electronic filing of documents. However, because the current rules of practice (title 37, Code of Federal Regulations) are directed almost exclusively to paper submissions, the rules do not speak to electronic submissions. To the extent that any USPTO rule is inconsistent with EFS, the rule will be waived until regulations directed to electronic submissions are promulgated. *See* Electronic Filing System Available to Public, 1240 Off. Gaz. Pat. Office 45 (Nov 14, 2000) and 37 CFR 1.183. When the Office has more experience with electronic submissions, the Office will amend the rules of practice under its rulemaking authority.

The waiver applies only to the documents authorized for filing under EFS. Documents that are not authorized for submission under EFS will not be granted the coverage of the above mentioned waiver. For example, the scanned image of an Information Disclosure Statement is not among the documents that may be submitted under EFS, and cannot be submitted under the guise of a drawing or declaration attachment.

The procedures and policies of the EFS are described in this document and the published manuals for EFS located on the USPTO Patents Electronic Business Center Web site, at <http://www.uspto.gov/ebc>. Some of the current regulations, for example, in 37 CFR 1.4, 1.6, and 1.52, refer to the paper and ink physical counterparts of an electronic submission. Submitted documents compliant with the requirements expressed in the EFS documentation will not be held to violate such regulations solely because of their electronic nature or the electronic submission process.

Currently, the EFS may only be used to submit 1) certain non-provisional utility patent applications, provisional applications, or "Sequence Listings," and 2) patent applications for purposes of having the patent application published. Those submissions are itemized in the USPTO web site, and discussed in this document below. Patent assignment information may also be electronically filed for recording with or without a patent application. Refer to the EFS user manuals for guidance on the USPTO Patents Electronic Business Center Web site, at <http://www.uspto.gov/ebc>.

The rest of this document explains, the submission process and the subsequent handling of submissions under the EFS, including New Utility Patent Application Submissions (Part I),

Provisional Application Submissions, (Part II), Submissions under Eighteen-Month Publication (Part III) and Submissions on Compact Disc. (Part IV).

PART I: UTILITY PATENT APPLICATIONS FILED UNDER THE ELECTRONIC FILING SYSTEM

Background: How are new applications processed under the Electronic Filing System (EFS)?

Applications filed under the EFS are maintained in confidence as required by 35 USC § 122(a), until the application is published or a patent is issued. Public Key Infrastructure (PKI) software assures the integrity, authenticity, non-repudiation and confidentiality of the applications. USPTO standards are commensurate with the state of the art in electronic commerce across the Internet.

Most provisional and non-provisional utility patent applications can be filed using EFS. However, the following types of applications must be filed in paper form: continued prosecution applications (CPAs), design applications, plant applications, national security applications, and international applications under the PCT. Very large applications (over 10 megabytes in size) are also inappropriate for the EFS, unless the compact disc provisions of Part IV are utilized.

The process for handling the EFS applications is shown on Attachment 1 at the end of this document. Note the following overview of the process:

- A. Applications are "authored" by the applicant or attorney using the USPTO-provided word processing templates that render the application into special eXtensible Markup Language (XML) formats designed to be accurately processed by the Office's computers. The word processing templates, available in either Microsoft Word or WordPerfect format, render a patent application into an XML encoded document with invisible tags that identify the text content of each element of the specification. For example, one XML tag will identify the title and a separate tag will identify the first claim. These tags also control the presentation of the specification in a standard Internet browser form that can be processed by the USPTO's automated systems. The XML tags created in EFS submissions permit the development of automatic application formality review processing and form the basis for the future electronic file wrapper that will ultimately replace paper application files in the USPTO. Drawings and complex work units, e.g., math or chemical equations, and complex tables, may be included in the applications, formatted as TIFF files, and referenced in the text, according to the instructions in the Users Guide.
- B. Patent application files, once properly formatted in XML, are saved on the users' computer. Additional XML files for the application are created using the submission software, called ePAVE (electronic packaging and validation engine). The complete patent application is assembled from the various text and data files and validated and electronically signed, after review by the applicant or the representative. The application is then digitally signed, encrypted, wrapped, and electronically transmitted

to the USPTO by ePAVE. Applicant is strongly urged to maintain an electronic copy of this file, similar in concept to the admonition of 37 CFR 1.4(d)(1)(ii).

- C. After receipt at the USPTO, the electronic files are checked for technical compliance, virus infection and data integrity.

The digital signature system, part of the public key infrastructure (PKI) mentioned above, will be tested and ordinarily assure that the files were not altered since they were signed, and all the documents were received from the applicant. After the automated tests, an electronic Acknowledgement Receipt including the application number will then be produced and sent to the applicant to as evidence of a successful submission. The Acknowledgement Receipt also lists the files received by the USPTO listing the file names and the sizes of each file, and includes a Message Digest code that is derived from the whole submission and is unique to the submission. The applicant should retain this Acknowledgement Receipt as clear evidence that on the date noted the files were successfully received by the USPTO. This "Electronic Post Card" is a very valuable assurance to the applicant should the files or their resultant paper documents ever be lost or damaged.

Please note: Receipt of an Acknowledgement Receipt does not mean that the application meets all the USPTO requirements for a filing date. For example, any drawings that are submitted as part of an EFS submission may not be of sufficient quality to provide an adequate illustration of the invention (35 USC § 113, first sentence). The Office will contact applicant if problems are discovered in review of the submission.

If the files are not complete, unaltered, readable and usable, the applicant is immediately alerted by a return message that does not include an Acknowledgement Receipt as described above. The return message will, instead, indicate to the applicant that a problem has occurred. The applicant will be advised to contact the USPTO for help.

What is the official submission of the new application under the EFS?

The official copies of all documents are the paper copies printed in step 8 in Attachment 1 below, entered into the Office files. After appropriate processing, an official paper Filing Receipt will be sent by postal mail.

May a Computer Readable Form (CRF) of Biotechnology Sequence Listings still be submitted with the EFS?

Yes, the EFS may be used to submit the CRF submission required of biotechnology applications under 37 CFR 1.821(e) for applications that have already been submitted and have an Application Number and a confirmation number, or for new biotechnology applications being concurrently submitted using EFS.

May specification document appendix data (e.g. computer listings and/or large tables) be submitted with the EFS?

Yes, the Fall 2001 release of EFS submission software enables the electronic filing of appendix data authored in a text (ASCII) format under 37 CFR 1.58(b) and 1.96.

What is the force and effect of the Acknowledgement Receipt sent by the USPTO under the EFS?

The acknowledgements and notifications to the applicant indicated above in this EFS process do not constitute the granting of an official filing date for the application. That official date will be noted on the paper Filing Receipt (37 CFR 1.54), PTO Form-103X, which is sent after printing the application in step 8 in Attachment 1 below, and reviewing the submitted application parts for compliance with 35 U.S.C. § 111 filing date requirements. However, the Acknowledgement Receipt establishes the date of successful submission of the associated documents, and is thus a crucial part of the application process.

What is the value of the Acknowledgement Receipt if a problem occurs?

If the printed version of any document received by the EFS is unreadable, and if it cannot be recovered from the stored files received by electronic submission, then the applicant will be promptly notified by phone, fax or e-mail as indicated in the EFS instruction. Even with prompt processing, if EFS receipts are high the review may take place a few days or a week later. If an error occurred and the application cannot be reconstructed, the applicant may have to resubmit the application and petition for the original filing date. Such events are expected to be rare. Under this scenario, the applicant would present 1) the Acknowledgement Receipt, 2) a paper version and an electronic version (on floppy disk or CD-R) of the files as submitted and 3) a petition verifying that the attached files are exactly the same as mentioned in the Acknowledgement Receipt for that application number. The Acknowledgement Receipt will establish that the resubmitted documents were exactly those submitted on the date of receipt. However, the Acknowledgement Receipt is of no value should an applicant submit the wrong data files under EFS, just as a post card receipt has no value should an applicant submit a wrong application in paper filings. Applicants are responsible for ensuring that a filing contains the correct, intended application files.

What is the date of receipt of an application received under the EFS?

The application's "date of receipt" is the date that it is fully and successfully received at the USPTO, as shown on the Acknowledgement Receipt. The date at the USPTO is controlling for the purposes of original patent applications. There is no "certificate of transmission" practice for new application or provisional application e-filings (37 CFR 1.8).

Hours of operation of the EFS will be clearly expressed in the EFS instructions. If a transmission is attempted during a down time, the Office cannot accept it and will, if possible, transmit back a notice that the Office is closed. No Acknowledgement Receipt will be sent. The "closed" notice will advise the applicant to use alternative filing methods, such as hand delivery of paper to the USPTO or Express Mail (under 37 CFR 1.10), to establish the filing date. Note that new applications filed under 37 CFR 1.53 cannot be submitted by fax (37 CFR 1.6(d)(3)), and that normal certificate of mailing procedures do not apply to new

applications (37 CFR 1.8(a)(2)(i)(A) and (D)). Applicants are strongly advised to transmit their electronic filings sufficiently early in the day to allow time for alternative paper filing when transmission cannot be initiated or correctly completed.

If an application is successfully received on a Saturday, Sunday or Federal holiday within the District of Columbia, the Office will assign that receipt date at the USPTO to the submission.

Are there any legal consequences of the Office's accepting electronic patent applications on Saturday and Sunday?

The USPTO will be open for receiving applications in electronic form during scheduled hours every day of the week. Hours will be announced on the Patents Electronic Business Center Web Page, at the USPTO Website: <http://www.uspto.gov/ebc>.

Electronic filing with EFS will provide applicants with the opportunity to receive a filing date on any day of the week, including Saturday, Sunday, and Federal holiday within the District of Columbia. In addition, consistent with 35 U.S.C. § 21(b), when the last day for taking any action or paying any fee in the USPTO falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken or fee paid on the next succeeding secular or business day. Thus, under United States law, applicants will still be permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing.

Because the conditions for priority rights are governed by the national law in the country of filing, applicants are cautioned to consider possible adverse consequences regarding the determination of priority periods under Article 4(C)(3) of the Paris Convention when filing international applications in the United States. Specifically, the ability to file applications electronically on weekends *may* result in loss of priority rights in foreign jurisdictions designated in international applications filed with the USPTO, if applicants elect to take advantage of sections 21(b) or 119(e)(3) of title 35. In such circumstances, other Patent Offices *may* deny the priority claim on the basis that the international application was not timely filed according to their national law. For this reason, applicants may prefer not to rely upon the "next business day" provisions of sections 21(b) and 119(e)(3) of title 35 when filing applications with the USPTO, and instead file the application before the Convention year has expired.

PART 2: PROVISIONAL PATENT APPLICATIONS FILED UNDER THE ELECTRONIC FILING SYSTEM (EFS)

Provisional applications under 35 U.S.C. § 111(b) can be electronically filed using EFS. The process for handling EFS provisional patent applications follows the same process outlined in Part 1 of the Legal Framework and in Attachment 1 for new utility patent application EFS filings **except for** the following features of the process:

A. Provisional application must include the Application Data Sheet (37 CFR 1.76) as the cover sheet and to provide bibliographic information required by 37 CFR 1.51(c) (1). The entry of a customer number for a correspondence address will assign to the provisional application the correspondence address associated with the customer number and will enable

information about the application to be obtained using the private side of the Patent Application Information Retrieval (PAIR) system. The ePAVE system allows for the creation of the required Application Data Sheet.

B. The EFS transmittal form will automatically include information identifying the electronic submission as a provisional application.

C. If the provisional application submission to be electronically filed is subject to U.S. government property interest, an explanation should be entered on the EFS transmittal form comments section. Provisional applications containing national security related matter cannot be electronically filed.

D. Payment of the basic provisional filing fee is required.

E. The Acknowledgement Receipt returned after a successful electronic filing of a provisional application will contain the USPTO assigned provisional application number.

F. Provisional Application submissions under EFS will be printed to paper, reviewed for completeness, and a paper Filing Receipt will be mailed to the applicant. The paper File Wrapper containing the electronically filed documents (i.e., the provisional application) will not be examined or published. Note: the provisional application does not require the inclusion of a claim, oath or declaration.

G. Provisional Applications submitted under EFS must be only in the English language. The USPTO permits paper patent applications to be filed in a language other than English (37 CFR 1.52(d)), but applications submitted through the Electronic Filing System must currently be in the English language.

PART 3: EIGHTEEN-MONTH PUBLICATION SUBMISSIONS SUBMITTED UNDER THE ELECTRONIC FILING SYSTEM (EFS)

The same ePAVE software that is used for filing new patent applications under the EFS is also used for the re-submission of patent applications for the purposes of Eighteen-Month Publication. See 37 CFR 1.211-1.221 for the relevant rules.

Ordinarily, a paper copy of patent applications is used for the production of the Patent Application Publication. However, if applicant desires:

- a) the publication of a redacted copy of an application (37 CFR 1.217) or
- b) the publication of the application as amended (37 CFR 1.215) or
- c) the voluntary publication of an application filed before, but pending on November 29, 2000 under 37 CFR 1.221, or
- d) a republication under 37 CFR 1.221 of an application previously published under 37 CFR 1.211

then the application *must* be submitted in electronic form using the EFS. If the applicant requests early publication of the application under 37 CFR 1.219 he or she *may* submit an electronic copy using EFS, but EFS submissions are currently only able to be used for

publication purposes if the application was already on file in the USPTO. Accordingly, to obtain early publication either file the application on paper or through EFS, and, once a confirmation number is obtained (on the filing receipt), re-submit the application using EFS and with a request for early publication. Alternatively, the second EFS submission may be eliminated, but publication will be based upon a paper version of the application. Requests for early and voluntary publication and republication all require payment of publication and/or processing fees. *See* 37 CFR § 1.217-221.

Background: How are submissions handled under the Electronic Filing System (EFS) for Eighteen-Month Publication?

The process for handling the EFS submission for PG Pub is shown on Attachment 2 below. Note the following features of the process:

- A. Applications (including plant patent applications) that are submitted for redacted, “as amended”, voluntary, “previously published” or, optionally, “early” Patent Application Publications are authored using the USPTO-provided authoring tools as described for new applications above. They must contain a statement that the submission does not include any “new matter.”
- B. Application files, once properly authored, are assembled, validated, encrypted, digitally signed, wrapped and electronically transmitted to the USPTO. This is the same process used for new applications described above.
- C. After receipt at the USPTO, the electronic files are checked for technical compliance, freedom from viruses and apparent data integrity as described above for new applications. The Eighteen-Month Publication submissions are transferred to the facility that edits, publishes and produces the Published Patent Application documents directly in electronic form.

Where does the applicant indicate or author the required statement that this resubmission of the application contains no new matter? What other certifications are effective?

The following statement is automatically entered and printed on the completed EFS Application Data Sheet for every Eighteen-Month Publication electronic submission:

“I state that this resubmission of the application contains no new matter. If this resubmission is a redacted copy of an application submitted under CFR 1.217, the applicant hereby certifies that the redacted copy of the application eliminates only the part of description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office and otherwise does not introduce any new matter. Additionally, if this submission is a redacted copy of an application submitted under 37 CFR 1.217, the applicant further certifies that the documents and certification required by 37 CFR 1.217(c) will be filed in paper.”

In accordance with 37 CFR 10.18(b), by presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that –

1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document.

Entry of one electronic signature appearing on the EFS submission transmittal will acknowledge all the certification statements contained in the EFS submission.

May the applicant use a certificate of transmission?

Electronic submissions for Eighteen-Month Publication under EFS of “as amended” applications, “voluntary” or “previously published” publications, or, optionally, “early” publications may be submitted with a certificate of transmission. Consistent with the certificate practice of 37 CFR 1.8, the local date at the place of submission as indicated on the certificate of transmission will be considered for the purposes of determining if the electronic applications were submitted in a timely manner. This does not apply to “redacted” applications submitted under 37 CFR 1.217 that must be received on the specified date at the USPTO.

PART 4: EFS FILING SCENARIO FOR LARGE SUBMISSIONS USING COMPACT DISCS:

If an applicant or attorney attempts to file a patent application or Eighteen-Month Publication submission that exceeds the EFS system limit of 10 Megabytes, the system will generate an error message and advise the applicant to submit the large application on compact discs (hereinafter CDs or CD-Rs). The submission cannot be forwarded to USPTO over the Internet using ePAVE. If a large biotechnology sequence listing, tables or computer program listing caused the large application size, the applicant has the option of submitting the application according to the requirements of 37 CFR 1.52(e) with the large section on CD and the rest in paper. However, regardless of the cause of the large size of the submission, EFS can also be used to file the application in the following manner. The process requires the workstation to be connected to a compact disc recorder:

The process for handling large submissions is diagramed in Attachment 3. Applicant, on creating a large application (greater than 10 megabytes) will be instructed by ePAVE to:

1. Print out the transmittal form.
2. Copy the two files indicated by ePAVE to compact disc-recordable (CD-R) media. These files contain the whole application; do not include other files. Do not use floppy or Zip disks or other media.
3. Wrap the CD in a hard case within a padded protective mailing envelope, attached to the transmittal form. Enclose a cover letter explaining that the submission contains an application that was too large to be submitted under the EFS ePAVE process.
4. Hand carry, or mail the CD-R and a copy of the paper Transmittal Form, with the cover letter to the USPTO, or deposit them with the US Postal Service under the Express Mail procedures of 37 CFR 1.10.

Applicant is advised to keep a copy of the CD and transmittal form for his or her records. In step 2 above, an applicant with concerns about readability may optionally make a backup copy of the CD and send in both copies to the USPTO. Label the CDs "Copy 1" and "Copy 2" and include a signed statement that the two copies are identical. Copy 1 will be used for processing, unless it is unreadable. Applicant is advised to electronically "compare" the file on the CD with the files on the computer to be sure of accuracy.

The USPTO will receive the application package in the mailroom. The date of receipt of the application will be recorded. In due course, the CD will be "uploaded" to the EFS server, where the files are unsigned, decrypted and unzipped. The application files will then be processed as EFS submissions.

If the submission was a new application (as opposed to a resubmission of an application under 18-Month Publication), an Acknowledgement Form will be printed. However, the Acknowledgement Form will be modified to indicate that the USPTO mail room date of receipt of the CDs, or the Express Mail date when they were submitted to the USPS, is the date of their receipt (the date of uploading to the server will NOT be used). The Acknowledgement Form is placed in the file with the printed application, and a copy is sent back to the applicant.

If the files contain large tables, sequence listings or computer program listings, the Office has the option of not printing the large files, but rather creating two CD-Rs of such data, and treating them under the CD practice of 37 CFR 1.52(e). If the file is an amino acid/ nucleotide sequence listing, then one additional copy of such a sequence listing will be created and used as the CRF. In any case, one CD is placed in the file, and one is put in the Office's CD repository.

In other respects, processing will continue as if the application had been submitted by the standard EFS channels.

What is Receipt Date for EFS New Utility or Provisional Application Filing?

The filing date of any EFS new utility or provisional application sent in by CD (in a "CD package", including a paper copy of the ePAVE transmittal form) will be based on the date the CD package is received at USPTO, if delivered by hand or regular US mail. That date will be indicated in any acknowledgment. If the CD package was sent to the USPTO by Express Mail under 37 CFR 1.10, then the date of deposit with the United States Postal Service will be used. The Office will mail an Official filing receipt in due course if the submission is entitled to a filing date.

What is the official copy of the Sequence Listing (37 CFR 1.821 (c)), Table, Program Listing?

For applications that are originally filed using EFS, the paper copy of the specification that is printed from the EFS submission, and placed in the file wrapper is the official copy, with one exception. Sequence listings, large tables, and computer program listings may be submitted on only CD media, according to 37 CFR 1.52(e). If the Office decides, in a particular instance, to copy a sequence listing file, computer program listing or large table onto CDs instead of printing it to paper, the CDs become the official copy. The decision of media, paper or CD, is dependent on the length of the submission and feasibility of printing it to paper. The Office will follow the procedures of 37 CFR 1.821. "Official copy" means the active authoritative copy.

May an applicant submit more than one copy of the CD to assure readability?

Applicant is required to submit only one EFS new utility application CD. However, an applicant with concerns about readability of the CD by the Office has the option of submitting a second copy of the CD, but must label the two copies "Copy 1" and "Copy 2", and certify that Copy 1 and Copy 2 are the same. Copy 1 would be used for processing, unless it is unreadable

Will Express Mail - submission of EFS New Utility Application CD be accepted?

Yes

Should applicant/filer be advised to do a file size comparison between encrypted files copied to EFS New Utility Application CD and the EFS files residing on the applicant/filer's workstation?

Yes, the EFS Guide will advise applicants to do a file comparison.

For further information:

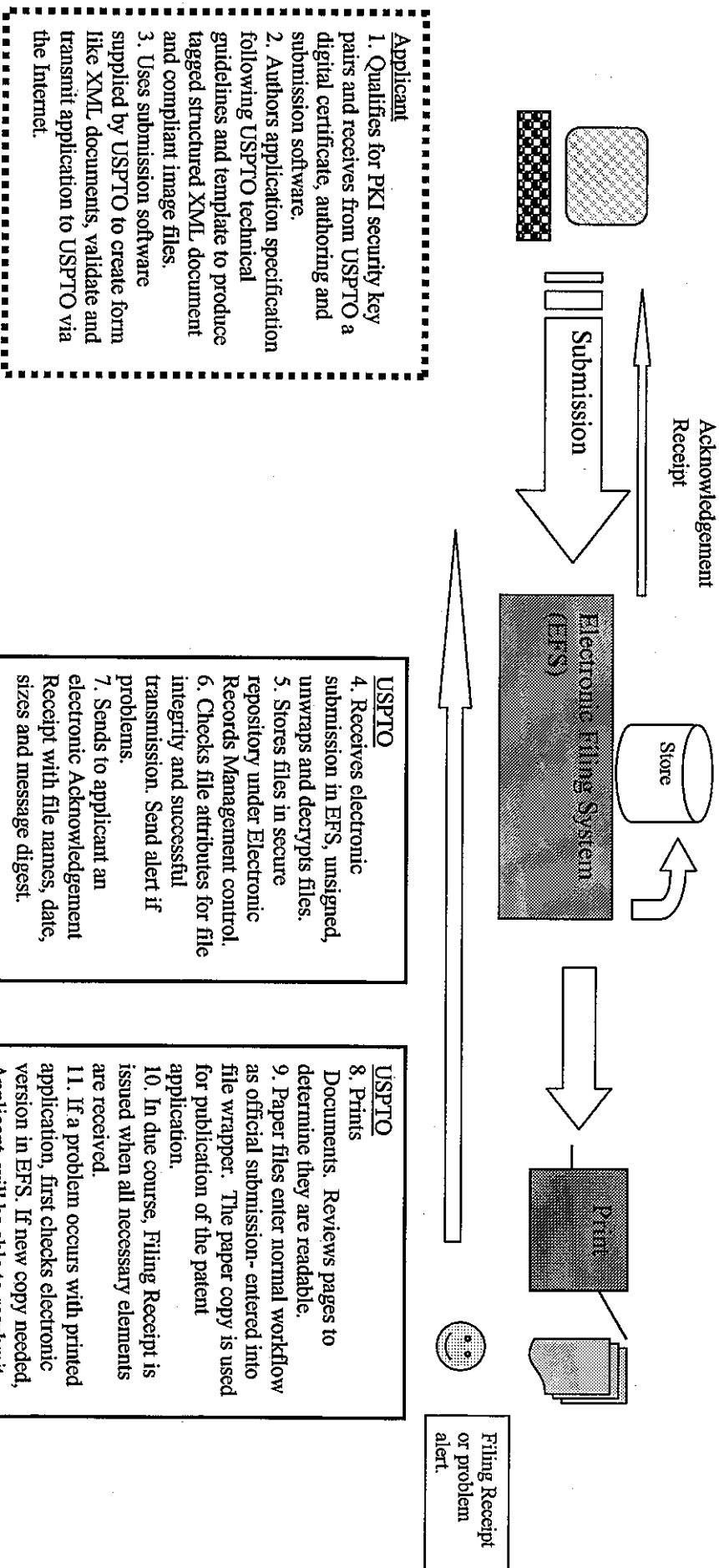
For further information, consult the EFS documentation on the USPTO Patents Electronic Business Center web page which includes a complete description of the EFS process and procedures. It is located on the Internet at <http://www.uspto.gov/ebc>

If there are any questions on the Legal Framework, please contact Mr. Jay Lucas at jay.lucas@uspto.gov . Questions on the EFS system should be directed to the SIRA/EFS project primary contact, Ms. Shelia Summerlin shelia.Summerlin@uspto.gov . Correspondence may also be addressed to Mr. Jay Lucas, United States Patent and Trademark Office, Washington, D.C. 20231.

A handwritten signature in black ink, reading "Stephen G. Kunin". The signature is written in a cursive, flowing style.

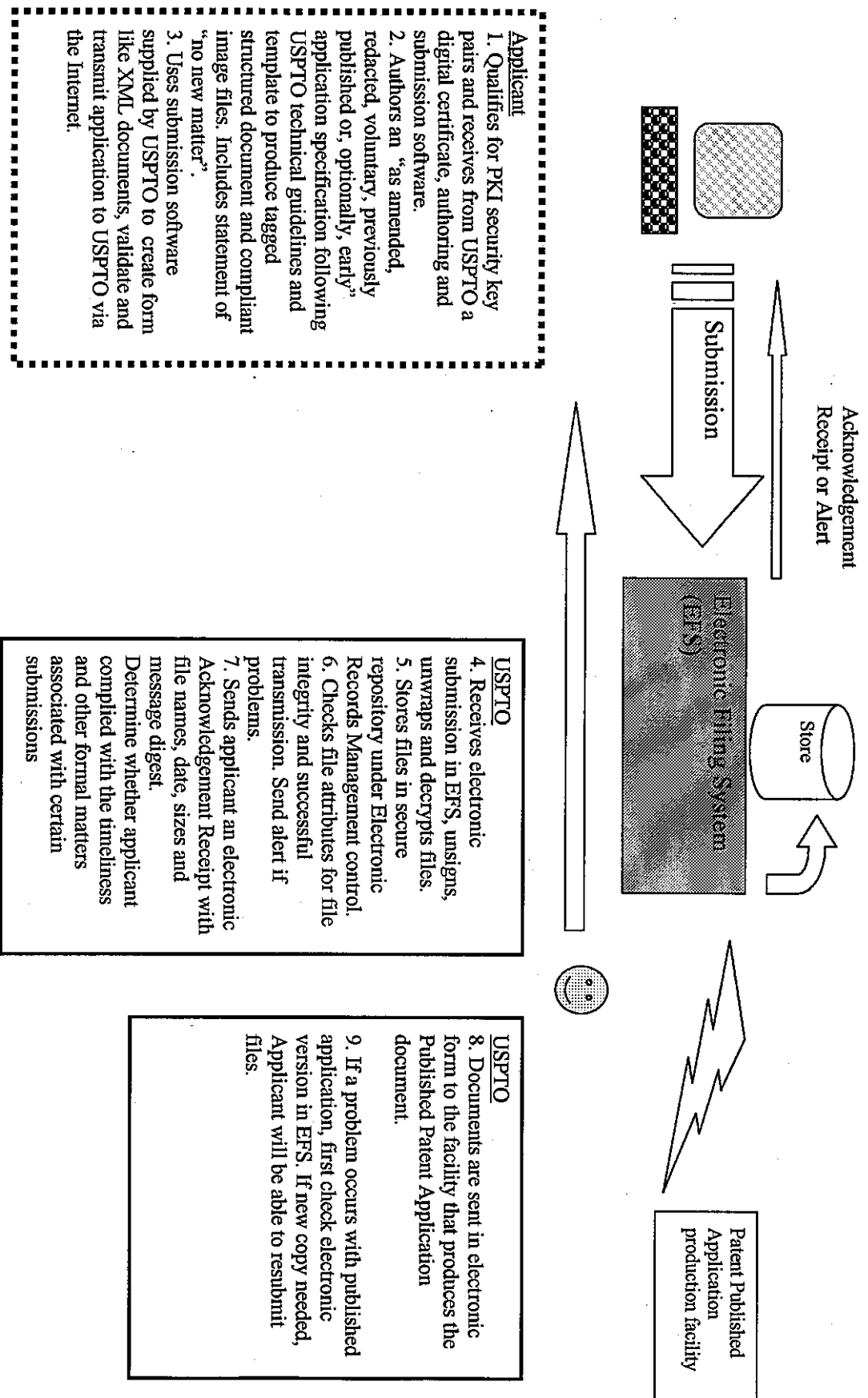
Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

ELECTRONIC FILING SYSTEM NEW APPLICATIONS



Attachment 2:

ELECTRONIC FILING SYSTEM PRE- GRANT PUBLICATION SUBMISSIONS



Attachment 3: EFS Filing Scenario with Compact Discs:

Applicant/Attorney attempts to file a New Utility Patent Application that exceeds the EFS system limit of 10 Megabytes and cannot be forwarded to USPTO over the Internet using ePAVE, EFS submission software.

Scenario Illustration:

